

The § 103 Standard

In making out a §103 rejection, the Federal Circuit has stated that when one or more reference or source of prior art is required in establishing obviousness, “it is necessary to ascertain whether the prior art *teachings* would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitutions or other modification.” *In re Fine*, 5 USPQ 2d, 1596, 1598 (Fed. Cir. 1988). That is, to make out a prima facie case of obviousness, the references must be examined to ascertain whether the combined *teachings* render the claimed subject matter obvious. *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979).

Moreover, there is a requirement that there must be some reason, suggestion, or motivation *from the prior art*, as a whole, for the person of ordinary skill to have combined or modified the references. *See, In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art *teaches away* from the claimed combination. A reference is said to teach away when a person or ordinary skill, upon reading the reference, would be led in a direction divergent from the path that the applicant took. *In re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir 1994).

1 In order for a prima facie case of obviousness to be made, the resulting
2 combination or motivation must appear to show or suggest the claimed invention.
3 *In re Nielson*, 2 USPQ 2d1525, 1528 (Fed. Cir. 1987).

4 In addition to the standard discussed above, the Office has provided a
5 paper, available at the following link:

6
7 <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm>
8

9 that describes proper and improper rejections made under §103(a).
10 Particularly instructive is Example 17 that appears in Section V of the paper
11 illustrating an improper §103(a) rejection which is based upon a proposed
12 motivation that is simply too general and lacking in particularity. This example is
13 reproduced below in its entirety for the Office's convenience:

14 **V. Examples of Improper Rejection under 35 U.S.C. 103**

15 Example 17: Improper rejection based upon hindsight - general
16 motivation statement.

17
18 **a. The claimed invention**

19 The invention is drawn to a smart card containing a tracking
20 mechanism, which tracks shopping preferences of consumers by recording
21 the type, quantity, and dates of purchase for a pre-selected group of
22 products. The smart card is useful in a system and method for introducing
23 new and alternative products that are of the same type as products normally
24 purchased by the shopper. The smart card records the shopper's purchases
25 and submits an automatic notification to the shopper when a quantity
threshold is achieved for the pre-selected products. This notification will
encourage the consumer to consider alternative products by providing the
consumer incentives, such as a pricing discount, to purchase an alternative
product.

1 Claim 1:

2
3 A method for using a smart card in a marketing analysis program designed to introduce new products, the method comprising the steps of:

4 storing product information on the smart card when said products are purchased by a consumer wherein said information including type, quantity and dates of the product purchased;

6 identifying for each product a threshold for each of said type, quantity and dates of products purchased;

7
8 determining an incentive for an alternative product based on said threshold; and

9
10 automatically notifying said consumer when said threshold is reached for a given product identified on the smart card and providing the consumer with said incentive, whereby the incentive encourages the consumer to consider alternative products.

12 **b. Evidence**

13 Reference A discloses smart card that tracks consumer preferences by recording the type, quantity, and dates of purchase of pre-selected products to determine trends in consumer purchases. The smart card is periodically read by a scanner to determine its contents for market analysis. In return for using the smart card and participating in the marketing program, the user is provided with free product coupons for products that are normally purchased by the shopper.

17 Reference B discloses a traditional consumer incentive program that provides coupons for the purchase of named products based upon the consumer's purchase of those same products to promote customer loyalty.

19 **c. Poor statement of the rejection**

20 Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Reference A in view of Reference B. Reference A discloses the conventional use of a smart card to track consumer preferences and provide incentives. However, Reference A does not disclose the automatic notification to consumer providing incentives. Reference B discloses providing incentives to consumers to purchase the desired products. *It would have been obvious to combine Reference A's smart card with Reference B's incentive to consumers because the combination would allow Reference A's smart card to be more efficient.*

1 **d. Analysis**

2 *The motivation, improve efficiency, is too general because it could*
3 *cover almost any alteration contemplated of Reference A and does not*
4 *address why this specific proposed modification would have been obvious.*

5 Additionally, there is nothing in either of references that would suggest
6 automatically notifying the consumer when reaching a threshold nor is
7 there anything in either reference that would suggest the notifying step.
8 Finally, although Reference B teaches a traditional coupon scheme to
9 promote customer loyalty, there is no suggestion, other than applicant's
10 disclosure, to employ this scheme to promote the introduction of new and
11 alternative products. **The rejection is improper.**

12 **Claims Rejected under 35 U.S.C. §103(a)**

13 **Claim 1** recites a method of providing a user experience when playing
14 media on a media player comprising:

- 15
- 16 • downloading a file that contains at least one media-specific file
17 configured to provide a user interface, and media content with which
18 the user interface is associated;
 - 19 • playing the media content with a media player; and
 - 20 • automatically displaying the user interface when the media content is
21 played with the media player.

22 In making out the rejection of this claim, the Office argues that Dwek
23 discloses "downloading", "playing" and "automatically displaying", as claimed.
24 The Office then relies on Chasen as disclosing "wherein the capability to
25 manipulate media specific file" and Bodin as disclosing "the capability to combine
multi media specific files into a single downloadable file to a user system". The
Office then argues it would have been obvious to combine Dwek with Bodin "in
order to optimize download delivery times for the transfer of files between
networked systems".

1 Applicant traverses this rejection and respectfully submits that the Office
2 has failed to establish a *prima facie* case of obviousness. First, neither Dwek nor
3 Bodin disclose or suggest “a file that contains *at least one media-specific file*
4 configured to provide a user interface, and media content with which the user
5 interface is associated”. (emphasis added). Instead, Dwek contemplates individual
6 separate and complete song files - which *teaches directly away* from this.
7 Anything else that might happen to be rendered in conjunction with a song, in
8 Dwek, does not come from the song file that is streamed across the Internet.

9 Furthermore, Bodin *teaches directly away* from such a file by disclosing “a
10 client/server system capable of downloading multiple separate files on a server to
11 a client machine”. In this respect, “[t]he server streams data dynamically to the
12 client without creating a physical file on the server machine.” (see Column 3,
13 lines 7-18 of Bodin) (emphasis added). In this regard, Applicant directs the
14 Office’s attention to Figs. 2 and 3 of Bodin which show “a display screen where
15 the user selects *the files resident on the server machine which will be*
16 *downloaded* to the client” and “a display screen showing *files selected* by a user”,
17 respectively. (emphasis added).

18 Second, the Office’s stated motivation “to optimize”, like the motivation
19 “to improve efficiency” (provided in the Office’s own example above), is too
20 general because it could cover almost any alteration contemplated of Dwek and
21 does not address why this specific proposed modification would have been
22 obvious. Furthermore, this stated motivation is not even relevant because
23 implementing the multiple separate file downloading system of Bodin would not
24 “optimize download delivery times for the transfer of files between networked
25 systems” in Dwek. Specifically, Dwek provides a media player with a user

1 interface that facilitates the delivery of multimedia content to a user over a
2 network. (see Abstract). In Dwek, a user only has to highlight a music selection
3 and *press play* once to have the selection *immediately streamed* across the internet
4 to be decompressed (on-the-fly) and played by the media player. (See Dwek,
5 Column 6). (emphasis added). In contrast, the system of Bodin is directed at
6 alleviating *a user* from the burden of having to *initiate several download sessions*
7 when downloading multiple associated files over the internet. (See Bodin, Column
8 1) (emphasis added). Accordingly, modifying Dwek with Bodin would not
9 optimize delivery times because a user in Dwek does not have to initiate several
10 download sessions to play a music selection. Instead, such a modification would
11 only interfere with the facilitative functions of Dwek's user interface.

12 Finally, modifying Dwek with Bodin would impermissibly change Dwek's
13 principle of operation and impermissibly render it unsatisfactory for its intended
14 purpose. (see MPEP 2143.01). Specifically, Bodin instructs that in order to
15 download a selected file along with the appropriate similarly related files, "a user
16 has to initiate several separate download sessions. (see Bodin, Column 2, lines 20-
17 43). In each of these sessions, "the user must specify which objects/files must be
18 obtained and where the files are to be stored on a client machine." Thus, in Bodin,
19 the onus is on the user to select the files. Modifying Dwek as suggested by the
20 Office would require the user to, for example, select the advertisements that they
21 wish to see and specify where the associated advertising files are to be stored.
22 Doing so, however, creates some problems. For example, the user would be
23 greatly burdened by this. In addition, Dwek does not contemplate the user
24 selecting advertisements at all. In fact, it does not make sense to have the user
25 select advertisements. Rather, Dwek teaches *directly away* from such notion by

1 specifically instructing that advertisements come from advertisers. Moreover,
2 giving the user the ability to select advertisements could conceivably lead to a
3 situation in which the user selects no advertisements. This is directly contrary to
4 one of the main purposes of Dwek – which is to remove the user's ability to
5 interact with advertisements.

6 In view of the above discussion, the Office has not established a *prima*
7 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
8 allowable.

9 **Claims 2-7** depend from claim 1 and are allowable as depending from an
10 allowable base claim. These claims are also allowable for their own recited
11 features which, in combination with those recited in claim 1, are neither disclosed
12 nor suggested in the references of record, either singly or in combination with one
13 another. In addition, given the allowability of claim 1, the rejection of claims 5
14 and 6 over the combination with Van Zoest, and the rejection of claim 7 over the
15 combination with England, is not seen to add anything of significance.

16 **Claim 8** recites one or more computer-readable media having computer
17 readable instructions thereon which, when executed by a computer, cause the
18 computer to:

- 19 • download a file that contains at least one media-specific file
- 20 configured to provide a user interface, and song files with which the
- 21 user interface is associated;
- 22 • play the song files with a media player; and
- 23 • automatically display the user interface when the song files are
- 24 played with the media player.
- 25

1 In making out the rejection of this claim, the Office relies on the same
2 argument that it made in regard to claim 1. Therefore, for the reasons given above
3 with respect to claim 1, Applicant traverses the Office's rejection and respectfully
4 submits that the Office has not established a *prima facie* case of obviousness.

5 Accordingly, for at least this reason, this claim is allowable.

6 **Claim 9** recites a media player comprising software code that is configured
7 to:

- 8
- 9 • download a file that contains at least one media-specific file
10 configured to provide a user interface, and media content with which
11 the user interface is associated;
- 12 • play the media content; and
- 13 • automatically display the user interface on at least a portion of a
14 media player user interface when the media content is played with
15 the media player.

16 In making out the rejection of this claim, the Office relies on the same
17 argument that it made in regard to claim 1. Therefore, for the reasons given above
18 with respect to claim 1, Applicant traverses the Office's rejection and respectfully
19 submits that the Office has not established a *prima facie* case of obviousness.

20 Accordingly, for at least this reason, this claim is allowable.

21 **Claims 10 and 11** depend from claim 9 and are allowable as depending
22 from an allowable base claim. These claims are also allowable for their own
23 recited features which, in combination with those recited in claim 9, are neither
24 disclosed nor suggested in the references of record, either singly or in combination
25 with one another. In addition, given the allowability of claim 9, the rejection of
claim 11 over the combination with England is not seen to add anything of
significance.

1 **Claim 12** recites a method of organizing media content comprising:

- 2
- 3 • providing at least one media-specific file that is configured to
- 4 provide a user interface on at least a portion of a media player;
- 5 • providing at least one media content file configured for play on the
- 6 media player; and
- 7 • associating the one media-specific file with the one media content
- 8 file such that any time the one media content file is played on the
- 9 media player, the one media-specific file is processed to
- 10 automatically display the user interface on at least a portion of the
- 11 media player,
- 12 • wherein said associating comprises packaging the one media-
- 13 specific file and the one media content file in a single downloadable
- 14 file.

15 In making out the rejection of this claim, the Office argues that Column 15

16 (lines 5-8 and 14-18) and Columns 11 (line 66) through 12 (line 4) of Dwek

17 disclose “providing at least one media-specific file that is configured to provide a

18 user interface on at least a portion of a media player”. Next, the Office argues that

19 Columns 11 (line 66) through 12 (line 4) disclose “associating the one media-

20 specific file with the one media content file”, as claimed. The Office then relies

21 on Chasen as disclosing “wherein the capability to manipulate media specific file”

22 and Bodin as disclosing “the capability to combine multi media specific files into

23 a single downloadable file to a user system”. The Office then argues it would

24 have been obvious to combine Dwek with Bodin “in order to optimize download

25 delivery times for the transfer of files between networked systems”.

26 Applicant traverses this rejection and respectfully submits that the Office

27 has failed to establish a *prima facie* case of obviousness. First, the Office has

28 mischaracterized Columns 11, 12 and 15 of Dwek. Specifically, the cited excerpt

29 from Columns 11 and 12 simply does not disclose “one media-specific file that is

1 *configured to provide a user interface*" or "associating the one media-specific
2 file with the one media content file *such that any time the one media content file*
3 *is played on the media player, the one media-specific file is processed to*
4 *automatically display the user interface* on at least a portion of the media player".
5 (emphasis added). Instead, this excerpt merely indicates that a features pane on a
6 user interface for a music player has a button that allows a user to create a custom
7 appearance template for the interface. This excerpt is reproduced below for the
8 Office's convenience:

9
10 The features pane 320e preferably includes a "skins" button to
11 allow a user to create, or select a precreated, "skin" or custom appearance
12 template for the user interface 250 of the music player 120. By changing
13 skins, a user can customize the size, shape, color, or other appearance
14 features of the panes, handles, and buttons of the user interface 250.

15 In addition, the cited excerpts from Column 15 merely indicate that the
16 advertisement pane may display advertisements which include "tie-ins to
17 particular music selections" and the information pane may include "information
18 about a music selection currently being delivered to the user's computer".
19 Missing is any discussion of "one media-specific file that is configured to provide
20 *a user interface*", as claimed. (emphasis added).

21 Second, the Office has mischaracterized Bodin, which neither discloses nor
22 suggests "packaging the one media-specific file and the one media content file in
23 *a single downloadable file*". (emphasis added). Instead, as noted above, Bodin
24 actually *teaches directly away* from this by disclosing "a client/server system
25 capable of downloading multiple separate files on a server to a client machine.
(emphasis added).

1 Third, as discussed above, the Office's stated motivation "to optimize", like
2 the motivation "to improve efficiency", is too general because it could cover
3 almost any alteration contemplated of Dwek and does not address why this
4 specific proposed modification would have been obvious. Furthermore, here, this
5 stated motivation is not even relevant because modifying Dwek with Bodin would
6 not provide any optimization of delivery times for the transfer of files, as the
7 Office contends.

8 Finally, as noted above, modifying Dwek with Bodin would impermissibly
9 change Dwek's principle of operation and impermissibly render it unsatisfactory
10 for its intended purpose.

11 In view of the above discussion, the Office has not established a *prima*
12 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
13 allowable.

14 **Claims 13-16 and 18** depend from claim 12 and are allowable as
15 depending from an allowable base claim. These claims are also allowable for their
16 own recited features which, in combination with those recited in claim 12, are
17 neither disclosed nor suggested in the references of record, either singly or in
18 combination with one another. In addition, given the allowability of claim 12, the
19 rejection of claim 13 over the combination with England, and claim 14 over the
20 combination with Van Zoest is not seen to add anything of significance.

21 **Claim 19** recites a method of organizing media content comprising:

- 22 • providing at least one media-specific file that is configured to
- 23 provide a media player user interface;
- 24 • providing at least one media content file configured for play on a
- 25 media player; and

- associating the one media-specific file with the one media content file such that any time the one media content file is played on the media player, the one media-specific file is processed to automatically display the media player user interface,
- wherein said associating comprises packaging the one media-specific file and the one media content file in a single downloadable file.

In making out the rejection of this claim, the Office argues that Column 15 (lines 5-8 and 14-18) and Columns 11 (line 66) through 12 (line 4) of Dwek disclose “providing at least one media-specific file that is configured to provide a media player user interface” and “associating the one media-specific file with the one media content file”, as claimed. The Office then relies on Chasen as disclosing “wherein the capability to manipulate media specific file” and Bodin as disclosing “the capability to combine multiple media specific files into a single downloadable file to a user system”. The Office then argues it would have been obvious to combine Dwek with Bodin “in order to optimize download delivery times for the transfer of files between networked systems”.

Applicant traverses this rejection and respectfully submits that the Office has failed to establish a *prima facie* case of obviousness. First, the Office has mischaracterized Columns 11, 12 and 15 of Dwek. Specifically, as noted above, the cited excerpts from Columns 11, 12 and 15 simply do not disclose “one media-specific file that is configured to provide a media player user interface” or “associating the one media-specific file with the one media content file”, as claimed. (emphasis added).

Second, as discussed above, the Office has mischaracterized Bodin, which actually teaches directly away from “packaging the one media-specific file and the

1 one media content file in a single downloadable file", as claimed. (emphasis
2 added).

3 Third, as discussed above, the Office's stated motivation "to optimize", like
4 the motivation "to improve efficiency", is too general because it could cover
5 almost any alteration contemplated of Dwek and does not address why this
6 specific proposed modification would have been obvious. Furthermore, here, this
7 stated motivation is not even relevant because modifying Dwek with Bodin would
8 not provide any optimization of delivery times for the transfer of files, as the
9 Office contends.

10 Finally, as noted above, modifying Dwek with Bodin would impermissibly
11 change Dwek's principle of operation and impermissibly render it unsatisfactory
12 for its intended purpose.

13 In view of the above discussion, the Office has not established a *prima*
14 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
15 allowable.

16 Claims 20-22 and 24 depend from claim 19 and are allowable as
17 depending from an allowable base claim. These claims are also allowable for their
18 own recited features which, in combination with those recited in claim 19, are
19 neither disclosed nor suggested in the references of record, either singly or in
20 combination with one another. In addition, given the allowability of claim 19, the
21 rejection of claim 20 over the combination with Van Zoest is not seen to add
22 anything of significance.

23 Claim 25 recites method of organizing content for a user experience
24 comprising:
25

- providing multiple different files that define different aspects of a media player user interface, at least some files being associated with media content and at least some other files being associated with visual content; and
- organizing the files for sending over a network to a client computer, said organizing using a hierarchical tag-based structure to establish a relationship between the files such that when the media content is played by a media player, the visual content is automatically displayed as at least part of the media player user interface.

In making out the rejection of this claim, the Office relies on Column 2 (lines 23-26 and 31-39) of Bodin as disclosing “providing multiple different files that define different aspects of a media player user interface” and “organizing using a hierarchical tag-based structure to establish a relationship between the files”, as claimed. The Office next argues that it would have been obvious to modify Dwek “to enable the download of multiple files within a single download event as taught by Bodin”. The Office states that it would have been obvious to combine Dwek with Bodin “in order to optimize download delivery times for the transfer of files between networked systems”.

Applicant traverses this rejection and respectfully submits that the Office has failed to establish a *prima facie* case of obviousness. First, these excerpts from Bodin simply fail to mention “providing multiple different files that define different aspects of a media player user interface” or a “hierarchical tag-based structure” to accomplish an organizing act as recited in this claim. (emphasis added). The Office has apparently taken a fanciful interpretation of these excerpts. The Office is not free to ascribe properties to Bodin that it simply does not appear to have.

1 Second, as discussed above, the Office's stated motivation "to optimize",
2 like the motivation "to improve efficiency", is too general because it could cover
3 *almost any alteration contemplated of Dwek and does not address why this*
4 *specific proposed modification would have been obvious.* Furthermore, here, this
5 stated motivation is not even relevant because modifying Dwek with Bodin would
6 not provide any optimization of delivery times for the transfer of files, as the
7 Office contends.

8 Finally, as noted above, modifying Dwek with Bodin would impermissibly
9 change Dwek's principle of operation and impermissibly render it unsatisfactory
10 for its intended purpose.

11 In view of the above discussion, the Office has not established a *prima*
12 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
13 allowable.

14 **Claims 26 and 27** depend from claim 25 and are allowable as depending
15 from an allowable base claim. These claims are also allowable for their own
16 recited features which, in combination with those recited in claim 25, are neither
17 disclosed nor suggested in the references of record, either singly or in combination
18 with one another. In addition, given the allowability of claim 25, the rejection of
19 claim 27 over the combination with Van Zoest is not seen to add anything of
20 significance.

21 **Claim 28** recites a method of accessing media content comprising:

- 22
- 23 • displaying a link to media content;
 - 24 • responsive to a user clicking on the link, automatically downloading
25 a file that contains at least one media content file and at least one file
that is configured to provide at least a portion of a media player user

1 interface that is specific to media content associated with the one
2 media content file;

- 3 • playing the media content on a media player; and
- 4 • responsive to said playing, automatically displaying said portion of
5 the media player user interface.

6 In making out the rejection of this claim, the Office argues that Dwek
7 discloses “displaying”, “automatically downloading”, “playing” and
8 “automatically displaying”, as claimed. The Office then relies on Chasen as
9 disclosing “wherein the capability to manipulate media specific file” and Bodin as
10 disclosing “the capability to combine multi media specific files into a single
11 downloadable file to a user system”. The Office argues it would have been
12 obvious to combine Dwek with Bodin “in order to optimize download delivery
13 times for the transfer of files between networked systems”.

14 Applicant traverses this rejection and respectfully submits that the Office
15 has failed to establish a *prima facie* case of obviousness. First, as discussed
16 above, neither Dwek nor Bodin disclose or suggest “a file that contains at least
17 one media content file and at least one file that is configured to provide at least a
18 portion of a media player user interface that is specific to media content associated
19 with the one media content file”. (emphasis added). Instead, Dwek *teaches*
20 *directly away* from this by contemplating separate and complete song files.
21 Similarly, Bodin *teaches directly away* from this by disclosing “a client/server
22 system capable of downloading multiple separate files on a server to a client
23 machine. (emphasis added).

24 Second, as discussed above, the Office’s stated motivation “to optimize”,
25 like the motivation “to improve efficiency”, is too general because it could cover
almost any alteration contemplated of Dwek and does not address why this

1 *specific proposed modification would have been obvious.* Furthermore, here, this
2 stated motivation is not even relevant because modifying Dwek with Bodin would
3 not provide any optimization of delivery times for the transfer of files, as the
4 Office contends.

5 Finally, as noted above, modifying Dwek with Bodin would impermissibly
6 change Dwek's principle of operation and impermissibly render it unsatisfactory
7 for its intended purpose.

8 In view of the above discussion, the Office has not established a *prima*
9 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
10 allowable.

11 **Claims 29 and 30** depend from claim 28 and are allowable as depending
12 from an allowable base claim. These claims are also allowable for their own
13 recited features which, in combination with those recited in claim 28, are neither
14 disclosed nor suggested in the references of record, either singly or in combination
15 with one another.

16 **Claim 31** recites one or more computer-readable media having computer
17 readable instructions thereon which, when executed by a computer, cause the
18 computer to:

- 19
- 20 • display a link to media content;
- 21 • responsive to a user clicking on the link, automatically download a
- 22 file that contains at least one media content file and at least one file
- 23 that is configured to provide at least a portion of a media player user
- 24 interface that is specific to media content associated with the one
- 25 media content file;
- play the media content on a media player; and
- responsive to playing the media content, automatically display said
- portion of the media player user interface.

1
2 In making out the rejection of this claim, the Office relies on the same
3 argument that it made in regard to claim 28. Therefore, for the reasons given
4 above with respect to claim 28, Applicant traverses the Office's rejection and
5 respectfully submits that the Office has not established a *prima facie* case of
6 obviousness.

7 Accordingly, for at least this reason, this claim is allowable.

8 **Claim 32** recites a media delivery mechanism comprising:

- 9
- 10 • a single file comprising:
 - 11 ○ one or more media content files associated with content that can
 - 12 be played on a media player;
 - 13 ○ one or more content-specific files that can be processed to
 - 14 provide a content-specific user interface associated with content
 - 15 that is played on the media player; and
 - 16 ○ a relationship between the one or more media content files and
 - 17 the one or more content-specific files such that a content-specific
 - 18 user interface is displayed on a computer when the content
 - 19 associated with the one or more media content files is played on
 - 20 the media player.

21 In making out the rejection of this claim, the Office argues that its subject
22 matter is obvious in view of Dwek and Bodin. Specifically, the Office again
23 argues that Column 15 (lines 5-8 and 14-18) and Columns 11 (line 66) through 12
24 (line 4) disclose all of the subject matter of this claim except for a single file. For
25 this feature, the Office relies on Bodin and argues that its combination with Dwek
would be motivated to "optimize downloaded delivery times for the transfer of
files between networked systems."

1 Applicant traverses this rejection and respectfully submits that the Office
2 has failed to establish a *prima facie* case of obviousness. First, the Office has
3 mischaracterized Columns 11, 12 and 15 of Dwek and Bodin. Specifically, as
4 noted above, the cited excerpts from Columns 11, 12 and 15 simply do not
5 disclose "a single file" that comprises "one or more media content files", "one or
6 more content-specific files" and "a relationship between the one or more media
7 content files and the one or more content-specific files", as claimed. (emphasis
8 added). Instead, Dwek *teaches directly away* from this by contemplating separate
9 and complete song files. Similarly, Bodin *teaches directly away* from "a single
10 file", as claimed, by disclosing "a client/server system capable of downloading
11 multiple separate files on a server to a client machine. (emphasis added).

12 Second, as discussed above, the Office's stated motivation "to optimize",
13 like the motivation "to improve efficiency", is too general because it could cover
14 almost any alteration contemplated of Dwek and does not address why this
15 specific proposed modification would have been obvious. Furthermore, here, this
16 stated motivation is not even relevant because modifying Dwek with Bodin would
17 not provide any optimization of delivery times for the transfer of files, as the
18 Office contends.

19 Finally, as noted above, modifying Dwek with Bodin would impermissibly
20 change Dwek's principle of operation and impermissibly render it unsatisfactory
21 for its intended purpose.

22 In view of the above discussion, the Office has not established a *prima*
23 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
24 allowable.
25

1 **Claims 33-38** depend from claim 32 and are allowable as depending from
2 an allowable base claim. These claims are also allowable for their own recited
3 features which, in combination with those recited in claim 32, are neither disclosed
4 nor suggested in the references of record, either singly or in combination with one
5 another. In addition, given the allowability of claim 32, the rejection of claim 34
6 over the combination with Van Zoest is not seen to add anything of significance.

7 **Claim 39** recites a method of providing a media delivery mechanism
8 comprising:

- 9 • providing one or more media-specific files, the files being
10 configured to provide at least a portion of a media player user
11 interface, said portion being associated with specific media that can
12 be played on a media player;
- 13 • providing one or more media content files associated with media that
14 can be played on a media player embodying the media player user
15 interface, said media content files comprising the specific media
16 with which the media player user interface portion is associated; and
- 17 • defining one or more metafiles that associate the one or more media-
18 specific files with the one or more media content files, the one or
19 more metafiles being configured for processing such that when the
20 media player plays media associated with a media content file, the
21 media player automatically renders the media player user interface
22 portion;
- 23 • associating the one or more media-specific files, the one or more
24 media content files, and the one or more metafiles in a single
25 downloadable file.

21 In making out the rejection of this claim, the Office argues that Column 15
22 (lines 5-8 and 14-18) and Columns 11 (line 66) through 12 (line 4) of Dwek
23 disclose “providing at least one media-specific file”, as claimed. Next, the Office
24 argues that Column 8 (lines 34-40) and 15 (lines 14-18) disclose “defining one or
25 more metafiles”, as claimed. The Office then relies on Chasen as disclosing

1 “wherein the capability to manipulate media specific file” and Bodin as disclosing
2 “the capability to combine multi media specific files into a single downloadable
3 file to a user system”. The Office argues it would have been obvious to combine
4 Dwek with Bodin “in order to optimize download delivery times for the transfer of
5 files between networked systems”.

6 Applicant traverses this rejection and respectfully submits that the Office
7 has failed to establish a *prima facie* case of obviousness. First, the Office has
8 mischaracterized Columns 11, 12 and 15 of Dwek. Specifically, the cited excerpt
9 from Columns 11 and 12 simply does not disclose “one or more media-specific
10 files, the files being configured to provide at least a portion of a media player user
11 interface”, as claimed. Instead, this excerpt (reproduced above) merely indicates
12 that a features pane on a user interface for a music player has a button that allows
13 a user to create a custom appearance template for the interface. Nothing discusses
14 “one or more media-specific files” that are configured in the manner recited in this
15 claim.

16 In addition, the cited excerpts from Column 15 merely indicate that the
17 advertisement pane may display advertisements which include “tie-ins to
18 particular music selections” and the information pane may include “information
19 about a music selection currently being delivered to the user’s computer”.
20 Missing again, however, is any discussion of “one or more media-specific files”
21 that are configured in the manner recited in this claim.

22 Second, as noted above, the Office has mischaracterized Bodin, which
23 neither discloses nor suggests “associating the one or more media-specific files,
24 the one or more media content files, and the one or more metafiles in a single
25 downloadable file.” (emphasis added). Instead, as noted above, Bodin actually

1 *teaches directly away* from this by disclosing "a client/server system capable of
2 downloading multiple separate files on a server to a client machine. (emphasis
3 added).

4 Third, as discussed above, the Office's stated motivation "to optimize", like
5 the motivation "to improve efficiency" *is too general because it could cover*
6 *almost any alteration contemplated of Dwek and does not address why this*
7 *specific proposed modification would have been obvious*. Furthermore, here, this
8 stated motivation is not even relevant because modifying Dwek with Bodin would
9 not provide any optimization of delivery times for the transfer of files, as the
10 Office contends.

11 Finally, as noted above, modifying Dwek with Bodin would impermissibly
12 change Dwek's principle of operation and impermissibly render it unsatisfactory
13 for its intended purpose.

14 In view of the above discussion, the Office has not established a *prima*
15 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
16 allowable.

17 **Claims 41-44** depend from claim 39 and are allowable as depending from
18 an allowable base claim. These claims are also allowable for their own recited
19 features which, in combination with those recited in claim 39, are neither disclosed
20 nor suggested in the references of record, either singly or in combination with one
21 another. In addition, given the allowability of claim 39, the rejection of claim 41
22 over the combination with England, and claim 43 over the combination with Van
23 Zoest, is not seen to add anything of significance.

1 **Claim 45** recites a method of providing media content over a network
2 comprising:

- 3 • receiving input requesting that a file be sent to a client computer, the
4 file comprising:
 - 5 ○ one or more media content files associated with content that can
6 be played on a media player on the client computer,
 - 7 ○ one or more media-specific files that can be processed to provide
8 a content-specific user interface, and
 - 9 ○ one or more metafiles that establish a relationship between the
10 one or more media content files and the one or more media
11 specific files such that a content-specific user interface is
12 displayed when the content is played on the media player; and
- 13 • sending the requested file to the client computer.

14 In making out the rejection of this claim, the Office argues that Column 15
15 (lines 5-8 and 14-18) and Columns 11 (line 66) through 12 (line 4) of Dwek
16 disclose “one or more media-specific files”, as claimed. Next, the Office argues
17 that Columns 8 (lines 34-40) and 15 (lines 14-18) disclose “one or more
18 metafiles”, as claimed. The Office then relies on Chasen as disclosing “wherein
19 the capability to manipulate media specific file” and Bodin as disclosing “the
20 capability to combine multi media specific files into a single downloadable file to
21 a user system”. The Office then argues it would have been obvious to combine
22 Dwek with Bodin “in order to optimize download delivery times for the transfer of
23 files between networked systems”.

24 Applicant traverses this rejection and respectfully submits that the Office
25 has failed to establish a *prima facie* case of obviousness. First, as noted above, the
Office has mischaracterized Columns 11, 12 and 15 of Dwek, which do not

1 disclose "one or more media-specific files that can be processed to provide a
2 content-specific user interface". (emphasis added).

3 Second, as noted above, the Office has mischaracterized Bodin, which
4 neither discloses nor suggests "a file be sent to a client computer" wherein "the
5 file" comprises "one or more media content files", "one or more media-specific
6 files" and "one or more metafiles", as claimed. (emphasis added). Instead, as
7 noted above, Bodin actually *teaches directly away* from this by disclosing "a
8 client/server system capable of downloading multiple separate files on a server to
9 a client machine. (emphasis added).

10 Third, as discussed above, the Office's stated motivation "to optimize", like
11 the motivation "to improve efficiency", *is too general because it could cover*
12 *almost any alteration contemplated of Dwek and does not address why this*
13 *specific proposed modification would have been obvious.* Furthermore, here, this
14 stated motivation is not even relevant because modifying Dwek with Bodin would
15 not provide any optimization of delivery times for the transfer of files, as the
16 Office contends.

17 Finally, as noted above, modifying Dwek with Bodin would impermissibly
18 change Dwek's principle of operation and impermissibly render it unsatisfactory
19 for its intended purpose.

20 In view of the above discussion, the Office has not established a *prima*
21 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
22 allowable.

23 **Claims 46-49** depend from claim 45 and are allowable as depending from
24 an allowable base claim. These claims are also allowable for their own recited
25 features which, in combination with those recited in claim 45, are neither disclosed

1 nor suggested in the references of record, either singly or in combination with one
2 another. In addition, given the allowability of claim 45, the rejection of claim 48
3 over the combination with Van Zoest is not seen to add anything of significance.

4 **Claim 50** recites a server computer comprising:

- 5
- 6 • at least one computer-readable media; and
- 7 • computer-readable instructions resident on the computer-readable
8 media which, when executed by the server, cause the server to:
 - 9 ○ maintain multiple files, each file comprising:
 - 10 ▪ one or more media content files associated with content that
11 can be played on a media player on the client computer,
 - 12 ▪ one or more media-specific files that can be processed to
13 provide a content-specific user interface, and
 - 14 ▪ one or more metafiles that establish a relationship between
15 the one or more media content files and the one or more
16 media specific files such that a content-specific user interface
17 is displayed when the content is played on the media player;
 - 18 ○ receive input requesting that one or more of the multiple files be
19 sent to a client computer; and
 - 20 ○ send the one or more requested files to the client computer.
- 21
- 22
- 23
- 24
- 25

15 In making out the rejection of this claim, the Office argues that Column 15
16 (lines 5-8 and 14-18) and Columns 11 (line 66) through 12 (line 4) of Dwek
17 disclose “one or more media-specific files”, as claimed. Next, the Office argues
18 that Columns 8 (lines 34-40) and 15 (lines 14-18) disclose “one or more
19 metafiles”, as claimed. The Office then relies on Chasen as disclosing “wherein
20 the capability to manipulate media specific file” and Bodin as disclosing “the
21 capability to combine multi media specific files into a single downloadable file to
22 a user system”. The Office argues it would have been obvious to combine Dwek
23 with Bodin “in order to optimize download delivery times for the transfer of files
24 between networked systems”.
25

1 Applicant traverses this rejection and respectfully submits that the Office
2 has failed to establish a *prima facie* case of obviousness. First, as noted above, the
3 Office has mischaracterized Columns 11, 12 and 15 of Dwek, which do not
4 disclose “one or more media-specific files that can be processed to provide a
5 content-specific user interface”. (emphasis added).

6 Second, as noted above, the Office has mischaracterized Bodin, which
7 neither discloses nor suggests “multiple files, each file comprising one or more
8 media content files”, “one or more media-specific files” and “one or more
9 metafiles”, as claimed. (emphasis added).

10 Third, as discussed above, the Office’s stated motivation “to optimize”, like
11 the motivation “to improve efficiency”, is too general because it could cover
12 almost any alteration contemplated of Dwek and does not address why this
13 specific proposed modification would have been obvious. Furthermore, here, this
14 stated motivation is not even relevant because modifying Dwek with Bodin would
15 not provide any optimization of delivery times for the transfer of files, as the
16 Office contends.

17 Finally, as noted above, modifying Dwek with Bodin would impermissibly
18 change Dwek’s principle of operation and impermissibly render it unsatisfactory
19 for its intended purpose.

20 In view of the above discussion, the Office has not established a *prima*
21 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
22 allowable.

23 **Claim 51** recites a method for playing media content on a media player
24 comprising:
25

- 1 • receiving a file with a client computer, the file comprising:
 - 2 ○ one or more media content files associated with content that can
 - 3 be rendered on a media player on the client computer,
 - 4 ○ at least one media-specific file that can be processed to provide a
 - 5 content-specific user interface, and
 - 6 ○ at least one metafile that establishes a relationship between the
 - 7 media content files and the media-specific files such that a
 - 8 content-specific user interface is provided when the content
 - 9 associated with the content files is played on the media player;
- 10 • playing content associated with the content files on the media player
- 11 embodied on the client computer; and
- 12 • while playing the content on the media player, displaying the
- 13 content-specific user interface.
- 14

15 In making out the rejection of this claim, the Office argues that Column 5
16 (lines 21-24) of Dwek discloses “at least one media-specific file”, as claimed.
17 Next, the Office argues that Columns 15 (lines 5-8 and 14-18) and Columns 11
18 (line 66) through 12 (line 4) disclose “playing” and “displaying”, as claimed. The
19 Office then relies on Chasen as disclosing “wherein the capability to manipulate
20 media specific file” and Bodin as disclosing “the capability to combine multi
21 media specific files into a single downloadable file to a user system”. The Office
22 argues it would have been obvious to combine Dwek with Bodin “in order to
23 optimize download delivery times for the transfer of files between networked
24 systems”.

25 Applicant traverses this rejection and respectfully submits that the Office
has failed to establish a *prima facie* case of obviousness. First, as noted above, the
Office has mischaracterized Columns 11, 12 and 15 of Dwek, which do not
disclose “at least one media-specific file that can be processed to provide a
content-specific user interface”. (emphasis added).

1 Second, as noted above, the Office has mischaracterized Bodin, which
2 neither discloses nor suggests "a file with a client computer, the file comprising:
3 one or more media content files", "at least one media-specific file" and "at least
4 one metafile", as claimed. (emphasis added).

5 Third, as discussed above, the Office's stated motivation "to optimize", like
6 the motivation "to improve efficiency", is too general because it could cover
7 almost any alteration contemplated of Dwek and does not address why this
8 specific proposed modification would have been obvious. Furthermore, here, this
9 stated motivation is not even relevant because modifying Dwek with Bodin would
10 not provide any optimization of delivery times for the transfer of files, as the
11 Office contends.

12 Finally, as noted above, modifying Dwek with Bodin would impermissibly
13 change Dwek's principle of operation and impermissibly render it unsatisfactory
14 for its intended purpose.

15 In view of the above discussion, the Office has not established a *prima*
16 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
17 allowable.

18 **Claims 52-54** depend from claim 51 and are allowable as depending from
19 an allowable base claim. These claims are also allowable for their own recited
20 features which, in combination with those recited in claim 51, are neither disclosed
21 nor suggested in the references of record, either singly or in combination with one
22 another.

23 **Claim 55** recites a media player comprising software code that is
24 configured to:
25

- 1 • receive a file with a client computer, the file comprising:
 - 2 ○ one or more media content files associated with content that can
 - 3 be rendered on the media player,
 - 4 ○ at least one media-specific file that can be processed to provide a
 - 5 content-specific user interface, and
 - 6 ○ at least one metafile that establishes a relationship between the
 - 7 media content files and the media-specific files such that a
 - 8 content-specific user interface is provided when the content
 - 9 associated with the content files is played on the media player;
- 10 • play content associated with the content files; and
- 11 • while playing the content, display the content-specific user interface.

12 In making out the rejection of this claim, the Office relies on the same
13 argument that it made in regard to claim 51. Therefore, for the reasons given
14 above with respect to claim 51, Applicant traverses the Office's rejection and
15 respectfully submits that the Office has not established a *prima facie* case of
16 obviousness.

17 Accordingly, for at least this reason, this claim is allowable.

18 **Claim 56** recites method for processing media content comprising:

- 19 • receiving a file with a client computer, the file comprising:
 - 20 ○ one or more media content files associated with content that can
 - 21 be rendered on a media player on the client computer,
 - 22 ○ at least one media-specific file that can be processed to provide a
 - 23 content-specific user interface, and
 - 24 ○ at least one metafile that establishes a relationship between the
 - 25 media content files and the media-specific files such that a
 - content-specific user interface is provided when the content
 - associated with the content files is played on the media player;
 - and
- automatically organizing the received files in one or more directories
- on a client computer hard drive without any intervention from a user,
- the files being organized in a manner that permits audio and visual
- content to be played on a media player without any intervention
- from the user.

1 In making out the rejection of this claim, the Office argues that Column 15
2 (lines 5-8 and 14-18) and Columns 11 (line 66) through 12 (line 4) of Dwek
3 disclose "at least one media-specific file", as claimed. Next, the Office argues that
4 Columns 8 (lines 34-40) and 15 (lines 14-18) disclose "one or more metafiles", as
5 claimed. The Office then relies on Column 7 (lines 51-62) as disclosing
6 "automatically organizing the received files", as claimed. Finally, the Office relies
7 on Chasen as disclosing "wherein the capability to manipulate media specific file"
8 and Bodin as disclosing "the capability to combine multi media specific files into
9 a single downloadable file to a user system". The Office argues it would have
10 been obvious to combine Dwek with Bodin "in order to optimize download
11 delivery times for the transfer of files between networked systems".

12 Applicant traverses this rejection and respectfully submits that the Office
13 has failed to establish a *prima facie* case of obviousness. First, as noted above, the
14 Office has mischaracterized Columns 11, 12 and 15 of Dwek, which do not
15 disclose "at least one media-specific file that can be processed to provide a
16 content-specific user interface. (emphasis added).

17 Second, as noted above, the Office has mischaracterized Bodin, which
18 neither discloses nor suggests "a file with a client computer, the file comprising:
19 one or more media content files", "at least one media-specific file", and "at least
20 one metafile", as claimed.

21 Third, Applicant submits that the cited excerpt from Column 7 of Dwek
22 simply does not to disclose or suggest "automatically organizing", as claimed.
23 Instead, this excerpt merely indicates that a user may view and select one or more
24 song files stored on a mass storage device associated with the user's computer.
25

1 Applicant fails to see how this excerpt is even germane to the subject matter
2 recited here. This excerpt is reproduced below for the Office's convenience:

3
4 In a preferred embodiment, the database display subpane 354 also
5 shows a directory structure for one or more mass storage devices
6 associated with the user's computer. Thus, the user may view and select
7 one or more song files stored on the mass storage devices. Preferably, the
8 music player 120 can retrieve and play music selections stored onto a
9 mass storage device in a variety of compressed audio formats, such as
MP3, REAL AUDIO.RTM., LIQUID AUDIO.TM. etc. Also, the music
player 120 may retrieve and play music selections stored on a compact
disc, or downloaded onto a hard disk drive of a user's computer, in an
uncompressed audio format.

10
11 Fourth, as discussed above, the Office's stated motivation "to optimize",
12 like the motivation "to improve efficiency", *is too general because it could cover*
13 *almost any alteration contemplated of Dwek and does not address why this*
14 *specific proposed modification would have been obvious.* Furthermore, here, this
15 stated motivation is not even relevant because modifying Dwek with Bodin would
16 not provide any optimization of delivery times for the transfer of files, as the
17 Office contends.

18 Finally, as noted above, modifying Dwek with Bodin would impermissibly
19 change Dwek's principle of operation and impermissibly render it unsatisfactory
20 for its intended purpose.

21 In view of the above discussion, the Office has not established a *prima*
22 *facie* case of obviousness. Accordingly, for at least this reason, this claim is
23 allowable.

24 **Claims 57-60** depend from claim 56 and are allowable as depending from
25 an allowable base claim. These claims are also allowable for their own recited

1 features which, in combination with those recited in claim 56, are neither disclosed
2 nor suggested in the references of record, either singly or in combination with one
3 another.

4 **Claim 61** recites a media player comprising software code configured to
5 cause the media player to:

- 6
7 • receive a file, the file comprising:
 - 8 ○ one or more media content files associated with content that can
be rendered on the media player,
 - 9 ○ at least one media-specific file that can be processed to provide a
content-specific user interface, and
 - 10 ○ at least one metafile that establishes a relationship between the
media content files and the media-specific files such that a
11 content-specific user interface is provided when the content
associated with the content files is played on the media player; and
- 12 • automatically organize the received files in one or more directories
13 on a client computer hard drive without any intervention from a user,
14 the files being organized in a manner that permits audio and visual
content to be played on the media player without any intervention
15 from the user.

16
17 In making out the rejection of this claim, the Office relies on the same
18 argument that it made in regard to claim 56. Therefore, for the reasons given
19 above with respect to claim 56, Applicant traverses the Office's rejection and
20 respectfully submits that the Office has not established a *prima facie* case of
21 obviousness.

22 Accordingly, for at least this reason, this claim is allowable.

23 **Claim 62** depends from claim 61 and is allowable as depending from an
24 allowable base claim. This claim is also allowable for its own recited features
25 which, in combination with those recited in claim 61, are neither disclosed nor

1 suggested in the references of record, either singly or in combination with one
2 another.

3 **Claim 63** recites a method of playing media content comprising:

- 4
- 5 • receiving a file with a client computer, the file comprising:
 - 6 ○ one or more media content files associated with content that can
7 be played on a media player on the client computer,
 - 8 ○ at least one media-specific file that can be processed to provide a
9 content-specific user interface, and
 - 10 ○ at least one metafile that establishes a relationship between the
11 media content files and the media-specific files such that a
12 content-specific user interface is provided when the content
13 associated with the content files is played on the media player;
14 and
 - 15 • automatically playing content associated with the one or more media
16 content files using a media player embodied on the client computer;
17 and
 - 18 • while playing said content, automatically displaying the content-
19 specific user interface.
- 20

21 In making out the rejection of this claim, the Office relies on the same
22 argument that it made in regard to claim 56. Therefore, for the reasons given
23 above with respect to claim 56, Applicant traverses the Office's rejection and
24 respectfully submits that the Office has not established a *prima facie* case of
25 obviousness.

Accordingly, for at least this reason, this claim is allowable.

Claims 64-65 depend from claim 63 and are allowable as depending from
an allowable base claim. These claims are also allowable for their own recited
features which, in combination with those recited in claim 63, are neither disclosed
nor suggested in the references of record, either singly or in combination with one
another.

1
2 **Conclusion**

3 All of the claims are in condition for allowance. Accordingly, Applicant
4 requests a Notice of Allowability be issued forthwith. **If the Office maintains its**
5 **rejections over the art, Applicant intends to appeal this case.**
6

7 Respectfully Submitted,

8
9 Dated: 8/1/2006

By: 

Rich Bucher
Reg. No. 57,971
(509) 324-9256